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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT

PAPER NUMBER

2683

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6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,092

Applicant(s)

FIORI, COSTANTINO

Examiner

Stephen M. D'Agosta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-17, 19-24 and 27 is/are rejected.
- 7) ☒ Claim(s) 18 and 25-26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Acknowledgement is made that this application is a 371 to a PCT.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4-21-01 is in compliance and accordingly, the information disclosure statement is being considered by the examiner.

Drawings

The drawings were received on 2-28-01 and have been reviewed by the draftsman and examiner.

Specification

1. The abstract of the disclosure is objected to because 1) it contains the word "means" in several places, 2) it uses the word "invention" and the application has not been patented yet, 3) the title should be removed. Correction is required. See MPEP § 608.01(b).
2. The case does not make reference (on the first page of the specification) that this application is a 371 to a PCT.

Preliminary Amendment

The preliminary amendment received 10-25-01 has been incorporated into the examined claims below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-17, 19-21, 23-24 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Carmen US 5,382,780 and further in view of Mostrom WO-9638819 and Vazvan WO97-45814 (hereafter Carmen, Mostrom and Vazvan).

As per **claim 15**, Carmen teaches a mobile system of telepayment of access rights to at least one service intended for use by motorists, which is a service dedicated to paying parking and/or teletolling, renewable remotely by wireless/radio paging (abstract, figures 1-10 and C1, L44-60) comprising:

But is silent on Means of transmission and a first portable terminal which also comprise an electronic card at the disposal of a user, able to be inserted into said first terminal so as to activate it and to give the user, upon reception of a signal from means of transmission, access to this service

Second portable terminal, at the disposal of the user, having access to a server linked to the means of transmission, this second terminal allowing this user to request downloading of utilization rights of the service or services onto the first portable terminal and to display them on the latter's display screen, against payment made by the second portable terminal.

Carmen does teach a radio/wireless portable time metering device (C2, L1-7 and C2, L42-44 and figure 4, #110) with remote control capability (C5, L7-14). The examiner interprets the remote access/remote control ability as being performed by the user via wireless link (phone, control device, etc.). Paramount to this motivation is Carmen's disclosure of wireless access/control to the parking device as well as it being known in the art that remote control exists as does the ability for a phone to use a SIM card. With regard to one or more servers being accessed, this is a design choice and

can be implemented on one (or more servers) as determined by the system implementor – Carmen teaches communicating with external server(s) for loading, auditing and verification (C2, L41-44).

Mostrom teaches a wireless device (eg. portable terminal) for traffic/parking checking that uses a smart card reader with display for use in a vehicle (abstract, page 6, 4th paragraph teaches smart card reader). Mostrom also teaches wireless transmission of electronic money to/from the smart card (page 15, 1-7) which reads on one wireless device (eg. mobile device with SIM card) being used to access another device (eg. parking meter). Hence, one can use said phone to update the SIM card in Carmen's invention via wireless link. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Carmen in view of Mostrom, such that a smart card used and transmits money electronically, to provide means for the user to pay wirelessly and not have to be physically located at a parking meter to pay.

Lastly, Vazvan teaches use of a portable device for remote purchase payment, remote bill payment and transferring of electronic cash (and other data) via a wireless system with Sim Cards (abstract, page 3, L3-8, figure 1-2) that can support vehicle parking metering (figures 7-8). Vazvan also teaches wirelessly accessing a remote server/host computer (figure 2, top right, #4).

Hence the examiner interprets Carmen's teaching of remote control capability, Mostrom's phone with SIM card and Vazvan's electronic updating system as being combined to read on the claim.

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom, such that one device with SIM card is used to wirelessly communicate with a second device used for parking metering functions, to provide a means for wirelessly communicating with a parked car running a meter (eg. to determine if time has expired, to update the SIM card with more money, etc.).

As per **claim 16**, Carmen teaches a system according to claim 15, **but is silent on** in which the first portable terminal is a radio paging receiver.

Both Mostrom and Vazvan teach use of a mobile device (eg. mobile phone, pager, etc.) that can access another terminal via wireless means (abstracts).

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom and Vazvan, such that the first portable terminal is a radio paging receiver, to provide means for the user to use wireless communications to connect to their parked vehicle and obtain status.

As per **claim 17**, Carmen in view of Mostrom and Vazvan teaches claim 16 in which the first portable terminal is equipped with an internal clock programmable by the server via an executable software which is downloaded to it, simultaneously with utilization rights of the service or services demanded and which, in the case of pay parking, debits according to the tariffs in force in the zone where the vehicle is parked, the allocated time bought by the user (C2, L41-44 teaches (down)loading and C2, L48-60 teaches determining parking zone, amount of time parked and deduction of appropriate amount of money).

As per **claim 19**, Carmen in view of Mostrom and Vazvan teaches claim 15 **but is silent on** in which the second portable terminal is a cellular phone, a PubliphoneTM or a specified terminal.

Mostrom teaches a parking metering system that has a communication unit (figures 1-2, #9 in both figures) that can be any wireless transceiver, to include a cell phone, Publiphone or a specified terminal.

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom and Vazvan, such that the second portable terminal is a cell phone/Publiphone/specified terminal, to support communication systems such as cellular to leverage it's currently installed ubiquitous coverage to support parking data transfer.

As per **claim 20**, Carmen in view of Mostrom and Vazvan teaches claim 19 **but is silent on** the cellular phone being equipped with a card reader.

Vazvan teaches a cell phone with SIM card/reader (page 3, L3-8) and Mostrom teaches a traffic/parking checking system that supports a SIM card reader (figure 2, #18 and abstract last sentence).

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom and Vazvan, such that the parking meter device's transceiver is cellular and supports a SIM card reader, to provide means for SIM card to uniquely identify the user as well as provide electronic money to be debited for parking.

As per **claim 21**, Carmen in view of Mostrom and Vazvan teaches claim 15 **but is silent on** wherein the server is linked to a radio paging server which is a cellular phone server.

Mostrom teaches a wireless device for traffic/parking checking that uses a smart card read with display for use in a vehicle (abstract). Mostrom also teaches wireless transmission of electronic money to/from the SIM card (page 15, 1-7) which reads on one wireless device (eg. mobile device with SIM card) being used to access another device (eg. parking meter) and Vazvan teaches remote purchase payment, remote bill payment and transferring of electronic cash (and other data) via a wireless system with Sim Cards (abstract, page 3, L3-8, figure 1-2) that can support vehicle parking metering (figures 7-8). Vazvan also teaches wirelessly accessing a remote server/host computer (figure 2, top right, #4).

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom and Vazvan, such that the server is linked to a wireless (ie. cellular, paging, etc.) server which is a cellular phone server, to provide wireless communications via known standards as well as to leverage coverage from pager/cellular infrastructure.

As per **claim 23**, Carmen in view of Mostrom and Vazvan teaches claim 15 **but is silent on** the communication network being radio, wired or cellular.

Both Mostrom and Vazvan teach use of wired/wireless networks (abstracts and figures).

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom and Vazvan, such that wired/wireless communications are supported, to provide access for local/remote users via wired or wireless capabilities.

As per **claim 24**, Carmen in view of Mostrom and Vazvan teaches claim 15 in which the utilization rights are a credit of units for allotted time (figure 5 shows various registers that reflect "time used", "time remaining", "amount used", "audit register", "zone data storage", etc.) which read on the claim of allotted time.

As per **claim 27**, Carmen in view of Mostrom and Vazvan teaches a mobile system for access to an onboard purse service intended for motorist users making it possible to transfer funds remotely by radio paging comprising means of transmission and a portable transponder terminal comprising a display screen and a keyboard installed in a vehicle (abstract, figures 1-10 and C1, L44-60)

but is silent on which also comprises an electronic card at the disposal of the user, able to be inserted in said terminal in such a way as to activate it and to give this user, upon reception of a signal from the means of emission, access to this service, command means integrated in this terminal, at the disposal of the user having access to a server linked to the means of emission, these command means making it possible for this user to request transfer of a given sum from the card to the portable terminal or from the portable terminal to the card.

Carmen does teach a radio/wireless portable time metering device (C2, L1-7 and C2, L42-44 and figure 4, #110) with remote control capability (C5, L7-14). The examiner interprets the remote access/remote control ability as being performed by the user via wireless link (phone, control device, etc.). Paramount to this motivation is Carmen's disclosure of wireless access/control to the parking device as well as it being known in the art that remote control exists as does the ability for a phone to use a SIM

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card. With regard to one or more servers being accessed, this is a design choice and can be implemented on one (or more servers) as determined by the system implementor – Carmen teaches communicating with external server(s) for loading, auditing and verification (C2, L41-44).

Mostrom teaches a wireless device (eg. portable terminal) for traffic/parking checking that uses a smart card reader with display for use in a vehicle (abstract, page 6, 4th paragraph teaches smart card reader). Mostrom also teaches wireless transmission of electronic money to/from the smart card (page 15, 1-7) which reads on one wireless device (eg. mobile device with SIM card) being used to access another device (eg. parking meter). Mostrom also teaches a system that uses a display (abstract, figure 2, #20) and keypad (figure 2, #21). Hence, one can use said phone to update the SIM card in Carmen's invention via wireless link. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Carmen in view of Mostrom, such that a smart card used and transmits money electronically, to provide means for the user to pay wirelessly and not have to be physically located at a parking meter to pay.

Lastly, Vazvan teaches use of a portable device for remote purchase payment, remote bill payment and transferring of electronic cash (and other data) via a wireless system with Sim Cards (abstract, page 3, L3-8, figure 1-2) that can support vehicle parking metering (figures 7-8). Vazvan also teaches wirelessly accessing a remote server/host computer (figure 2, top right, #4).

Hence the examiner interprets Carmen's teaching of remote control capability, Mostrom's phone with SIM card and Vazvan's electronic updating system as being combined to read on the claim.

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom, such that one device with SIM card is used to wirelessly communicate with a second device used for parking metering functions, to provide a means for wirelessly communicating with a parked car running a meter (eg. to determine if time has expired, to update the SIM card with more money, etc.).

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Claim 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Carmen in view of Mostrom and Vazvan as applied to claim 15 above, and further in view of Vu et al. US 6,557,104 (hereafter Vu).

As per **claim 22**, Carmen in view of Mostrom and Vazvan teaches claim 15 **but is silent on** where the electronic card is a virtual card.

Vu teaches a virtual smart card:

"For example, one method of remote user access involves the use of a secret key stored on a token and is known as challenge/response identification. The token may consist of any type of removable storage device, such as a floppy disk, a Fortezza card, PCMCIA card, smart card, or even a "virtual" smart card which exists only in software. Physical possession of the token allows the user to access the remote server (C1, L33-48).

Recognizing the costs associated with implementing physical smart card authentication systems, several companies have proposed using "virtual smart cards." As currently implemented, a virtual smart card exists in software, and runs as an application. The secret key is usually stored on a hard drive or a floppy disk and is protected by a Personal Identification Number (PIN). Thus, any machine which has the virtual smart card software and associated PIN can access the remote system". (C2, L30-43).

It would have been obvious to one skilled in the art at the time of the invention to modify Carmen in view of Mostrom and Vazvan, such that a virtual smart card is used, so the user does not have to carry a physical card with them (which can be lost).

Allowable Subject Matter

Claims 18 and 25-26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As per **claim 18**, Carmen in view of Mostrom and Vazvan does not teach a prepaid card is inserted in the first terminal, and in which this prepaid card is debited by the latter through the intermediary of its programmable clock under the conditions imposed by the server when the service is activated by the executable software which it is loaded.

As per **claim 25**, Carmen in view of Mostrom and Vazvan does not teach the second portable terminal, in a determined zone, has access to a same local server linked to the central server.

As per **claim 26**, Carmen in view of Mostrom and Vazvan does not teach use of HF aerial beacons, linked to command unit, making possible to send a periodic signal of

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interrogation of presence, in their respective control areas, of the first portable terminals onboard the parked vehicles in order to manage the individual situation of each of them.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Morrill Jr. US 5,991,749
2. Jhelmvik WO99-48062
3. Jonstromer US 6,142,369.
4. Lesner Jr. et al. US 5,402,475
5. Bird WO92-08210
6. Tseng US 5,563,491

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist on 703-306-0377.

SMD

